

REMARKS

This application has been reviewed in light of the Office Action dated March 29, 2007. Claims 1-8, 16-30 and 33-36 remain pending. Claims 1, 16, and 21 are in independent form. Favorable reconsideration is requested.

Claims 1, 2, 3, 16, 17, 18, 21, 22, 23, and 29-36 were rejected for obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,817,915 (*Kyogaku et al.*).

Initially, Applicants strongly believe that the claims of the present application are patentable over the art relied on by the Examiner for the reasons given in the Remarks section of the Response To Office Action filed on March 13, 2007.

Applicants now offer the following additional remarks in response to the Office Action dated March 29, 2007.

Independent Claim 1 is directed to a method for manufacturing an electron-emitting device. The method comprises a step for forming a solid-state insulating polymer film including a carbon atomic bond between a pair of electrodes formed on a substrate, step for heating the polymer film to change the polymer film into an electro-conductive film, and a step for providing a potential difference between the pair of electrodes to energize electrically the electro-conductive film. The step for providing the potential difference is conducted after the step for heating the polymer film.

Claim 1 of *Kyogaku et al.* recites:

1. A method of manufacturing an electron source, comprising the steps of: (A) providing a substrate on which a plurality of units and wirings are arranged, each unit comprising a pair of electrodes and a polymer film for

connecting the electrodes of the pair and the wirings respectively being connected to at least one of the plurality of units; (B) irradiating light onto a region of the substrate where two or more units and part of the wirings are arranged, to reduce resistivity of the polymer film in each of the two or more units; (C) forming a gap in a film obtained by performing the step (B), wherein for the irradiating light in step (B), a light absorptance of the wirings is lower than that of the electrodes.

Claim 6 of *Kyogaku et al.* depends from Claim 1, and recites further that the gap is formed by flowing an electric current through the film obtained by the step (B).

According to page 3 of the Office Action, “one of ordinary skill in the art would be able to [provide] the device of Kyogaku without any regard to the light absorptance of the wirings, since this appears to have no structural bearing on the overall device.” Thus, the Office Action’s position is understood to be that, despite the fact that Claim 1 of *Kyogaku et al.* is narrower than the rejected independent claims in the respect that it recites that the light absorptance of the wirings is lower than that of the electrodes, the claim still renders the broader independent claims of the present application obvious.

However, as is set out in MPEP § 804, the basis for double-patenting rejections where the rejected claim is not identical in scope to a claim in the patent, is that the rejection is necessary to prevent improper *time-wise* extension of patent protection.

*Kyogaku et al.* was filed on a later date (January 27, 2003) than the present application (August 30, 2001). Thus, any patent that issues from the present application will expire prior to the date on which *Kyogaku et al.* will expire, and it is not seen how there can be any improper time-wise extension posed by the present application. Accordingly, if the Examiner repeats such rejection, he is respectfully requested to explain in detail how such improper time-wise extension would arise.

Moreover, the Patent and Trademark Office controlled the rates of prosecution to cause the later filed application which matured into the *Kyogaku et al.* patent, to issue before the claims of the present, earlier-filed application. As such, a two-way obviousness test should have been applied, according to MPEP 804(II)(B)(1)(b). The Office Action, however, seemingly applied only a one-way test in that it addressed whether the independent claims are obvious over Claims 1 and 6 of *Kyogaku et al.*, but did not make any obviousness determination for Claims 1 and 6 of *Kyogaku et al.* in view of the claims of the present application. More particularly, although the Office Action stated that “one of ordinary skill in the art would be able to [provide] the device of Kyogaku without any regard to the light absorptance of the wirings, since this appears to have no structural bearing on the overall device”, the Office Action has failed to explain why it would have been obvious in view of the rejected claims of the present application, to provide an irradiating step in which a light absorptance of wirings is lower than that of electrodes, as provided in Claims 1 and 6 of *Kyogaku et al.* Indeed, the present application is not concerned with a need to achieve the technical advantage described at col. 2, lines 51-62 of *Kyogaku et al.*, and thus there would have been no motivation for one skilled in the art in view of the present application to provide those features. Neither does the Office Action explain why one skilled in the art would have been motivated to provide those features. Accordingly, it is respectfully submitted that it would not have been obvious in view of the rejected claims of the present application to provide those features of the methods recited in Claims 1 and 6 of *Kyogaku et al.*, and that the Office Action’s failure to apply a two-way obviousness test renders the double patenting rejection improper.

For all of these reasons, withdrawal of the double patenting rejection is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' attorney of record may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Frank A. DeLucia/  
Frank A. DeLucia  
Attorney for Applicants  
Registration No. 42,476

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

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